

REMARKS

At the time of the Office Action dated February 2, 2007, claims 1-17 were pending and rejected in this application.

On page 2 of the Office Action, the Examiner asserted that the title of the invention was not descriptive. In response, the Title has been changed to "SCRIPT GENERATION ENGINE AND MAPPING SEMANTIC MODELS FOR TARGET PLATFORM," as suggested by the Examiner.

CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 101

In the paragraph spanning pages 2 and 3 of the Office Action, the Examiner asserted the following:

Analysis: Claims 1-17 disclosed by the applicant as being "an application component distribution system...". Since the claims are each a series of steps to be performed on a computer the processes must be analyzed to determine whether they are statutory under 35 USC 101. Examiner interprets that the claims 1-17 are non-statutory because claims are program for processing set of instructions and configured to produce set of instructions therefore computer program itself is not a process so its functionality can not be realized. Therefore, claims 1-17 are merely a manipulating of a registry and mapping program listing which is not able to produce a useful results and practical application. Thus claims 1-17 are non-statutory and rejected under 35 USC 101.

At the outset, Applicants note that the Examiner's analysis is neither consistent with the law described by Federal Circuit or the Board of Patent Appeals and Interferences and that the Examiner has failed to follow the procedure outlined in the M.P.E.P. with regard to rejecting claims under 35 U.S.C. § 101. In this regard, the Examiner is directed to M.P.E.P. § 2106.

For example, referring to M.P.E.P. § 2106(II)(A):

Office personnel have the burden to establish a *prima facie* case that the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. 101. Compare *Musgrave*, 431 F.2d at 893, 167 USPQ at 289; *In re Foster*, 438 F.2d 1011, 1013, 169 USPQ 99, 101 (CCPA 1971). Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection.

The Examiner, however, has already admitted that the claimed invention produces a useful result (i.e., "configured to produce set of instructions").

Applicants also note that the U.S. Patent Office has already issued thousands, if not tens of thousands of patents, which include similar types of claims to that recited in claims 1, 5, 8, and 13 since the Federal Circuit's decision of State Street Bank & Trust Co. V. Signature Financial Group, Inc.¹ Although issued prior the State Street Bank decision, the Examiner is referred to U.S. Patent No. 5,333,184 (hereinafter the '184 patent). Claim 1 of the '184 patent is reproduced below:

1. A method for use in a telecommunications system in which interexchange calls initiated by each subscriber are automatically routed over the facilities of a particular one of a plurality of interexchange carriers associated with that subscriber, said method comprising the steps of:

generating a message record for an interexchange call between an originating subscriber and a terminating subscriber, and

including, in said message record, a primary interexchange carrier (PIC) indicator having a value which is a function of whether or not the interexchange carrier associated with said terminating subscriber is a predetermined one of said interexchange carriers.

¹ 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1999).

Upon reviewing this claim, it is readily apparent the claims merely describe manipulating data (e.g., the message record). However, if the Examiner's analysis on page 2 of the present Office Action was followed at the time the application, which matured into the '184 patent, was examined, then this claim would have been rejected under 35 U.S.C. § 101.

Applicants have referred to the '184 patent because this patent was the subject of the decision by the Federal Circuit in AT&T Corp. v. Excel Communications, Inc.² The conclusion of the Federal Circuit with regard to the '184 patent is "we find that the claimed subject matter is properly within the statutory scope of 101."

Applicants also note that both independent claims 1 and 5 recite "a script generation engine configured to produce a target specific set of instructions" (emphasis added). Thus, not only does the claim invention produce a useful, concrete, and tangible result, these claims specifically recite the useful, concrete, and tangible result being produced. The preamble of independent claims 8 and 13, which recite a method "generating an installation script," also specifically recite a useful, concrete, and tangible result being produced by the claimed invention.

In first full paragraph on page 3 of the Office Action, the Examiner asserted the following:

Analysis: Claims 13-17 disclosed by the applicant as being a "a machine readable storage...". Further, examiner interprets that claims 13-17 are not limited to tangible embodiment, instead being defined as including both tangible embodiments (e.g., [computer readable medium]) and

² 172 F.3d 1352, 50 USPQ2d 1447 (Fed. Cir. 1999).

intangible embodiments (e.g., [transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line; a signal, etc.]). As such, the claim is not limited to statutory subject matter and is therefore non-statutory. To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

In response, Applicants notes that the Examiner's "analysis" is in error. Although the Examiner asserts that the claimed "machine readable storage" (emphasis added) may include "intangible embodiments" such as "transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line; a signal, etc," the Examiner has neither provided factual support for this assertion or a reasoned explanation that supports this assertion. Applicants are unaware as to how "transmission media, radio frequency (RF), infrared (IR), a carrier wave, telephone line; a signal" could be considered by one having ordinary skill in the art as being "storage." These "intangible embodiments" described by the Examiner are used in the transmission of data, not the storage of data. Thus, the Examiner's analysis is flawed.

Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejections of claims 1-17 under 35 U.S.C. § 101.

**CLAIMS 1-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON
UNDERSETH ET AL., U.S. PATENT NO. 7,020,867 (HEREINAFTER UNDERSETH), IN VIEW OF
CLAUSSEN ET AL., U.S. PATENT NO. 6,981,212 (HEREINAFTER CLAUSSEN)**

On pages 2-6 of the Office Action, the Examiner asserted that Betts discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

Although Applicants disagree that the claimed invention is obvious based upon the Underseth in view of Claussen, to expedite prosecution of the Application, Applicants submit

that the reference to Claussen cannot be properly applied against the present Application under 35 U.S.C. § 103. As discussed in M.P.E.P. § 2146, a reference that qualifies as "prior art" only under 35 U.S.C. § 102(e) cannot be considered when determining whether an invention is obvious under 35 U.S.C. § 103, provided the prior art and the claimed invention were commonly owned at the time of the invention. See M.P.E.P. § 706.02(I).

**Application No. 10/725,728 (the present application) and
U.S. Patent No. 6,981,212 (Claussen) were, at the time the
invention was made, commonly owned by International Business
Machines Corporation**

Thus, under 35 U.S.C. § 103(c), the reference to Claussen cannot be considered by the Examiner when determining whether Applicants' invention is obvious under 35 U.S.C. § 103. Applicants, therefore, respectfully submit that the imposed rejection of claims 1-17 under 35 U.S.C. § 103 for obviousness based upon the Underseth in view of Claussen is not viable and, hence, solicit withdrawal thereof.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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